

REMARKS

In the Office Action dated 22 April 2004, the Examiner withdraws the restriction requirement and examines claims 1 – 10. In this response, Applicants amend newly reinstated claim 1 to incorporate the limitations of claim 10, amend claim 11 to incorporate the limitations of claim 19, cancel claims 10 and 19, and add new claims 24 and 25. New claims 24 and 25 include the limitations of original claim 1 with claims 6 and 7, respectively. In addition, Applicants note that in paper no. 17, the Examiner also withdrew previously added claims 20 – 23 for being drawn to a non-elected invention. Because the Examiner has withdrawn the restriction requirement, Applicants resubmit claims 20 – 23 and request the Examiner to examine these claims.

§102 & §103 Rejections

The Examiner rejected claims 1 – 4, 8, and 9 under 35 U.S.C. §102 as anticipated by U.S. Patent No. 6,516,466 to Jackson. The Examiner also rejected claims 1, 11 – 13, and 18 under 35 U.S.C. §102 as anticipated by U.S. Patent No. 5,594,779 to Goodman. Because independent claims 1 and 11 have been amended to include the limitations of dependent claims 10 and 19, and because dependent claims 10 and 19 were not subject to the anticipation rejection, Applicants submit that the amendments render the §102 rejection moot.

However, claims 10 and 19 were rejected under 35 U.S.C. §103 as unpatentable over Goodman in view of U.S. Patent No. 5,661,788 to Chin. In particular, the Examiner asserts that Chin discloses a cellular telephone with a screening memory, and that it would be obvious to one skilled in the art to modify Goodman with Chin to derive the

claimed invention. Because the screening memory limitations are now part of independent claims 1 and 11, the following remarks address the obviousness rejection as it now applies to claims 1 and 11.

Applicants' invention relates to a combination cellular telephone and entertainment module particularly adapted to leisure activities such as jogging, biking, and gardening. The entertainment module has computer memory that connects to a microprocessor and signal processing circuits, and stores audio and video in memory for subsequent playback under control of the microprocessor. However, people frequently do not wish to be interrupted by incoming calls during an athletic workout or other leisure activity. Thus, the present invention provides a call screening function that enables calls originating from certain pre-designated phones to automatically ring through to the user. As a result, the user may participate in leisure activities uninterrupted, while still being able to receive emergency calls or expected calls that the user cannot afford to miss. Further, when the user receives an incoming call from a phone on the pre-approved list, Applicant's invention will mute or stop the playback device. However, only incoming calls that are on the user's pre-approved list will trigger this function. Other incoming calls will not.

Claim 1 explicitly requires that "playback stops if said incoming call is from a caller on said list of preferred callers." Further, claim 11 explicitly requires that the microprocessor "stops playback of stored audio and video signals responsive to an incoming call from a preferred caller such that a user may receive said incoming call free from playback of said audio and video signals." Thus, Applicant's device mutes or

ceases the playback of the audio and video signals stored in memory only when the user receives a call from a pre-identified number associated with a preferred caller list.

As stated above, the Examiner asserts that the combination of Goodman with Chin renders claims 10 and 19, and therefore amended claims 1 and 11, obvious. Goodman teaches an entertainment module capable of storing audio and video signals for subsequent playback to the user. Chin teaches a call-screening feature that notifies a user of an incoming call only when the incoming call is from a caller on a list of preferred callers. Nothing in the prior art teaches or suggests combining an entertainment module with a call-screening feature. At best, the prior art teaches that both features (the entertainment module and the call-screening) are known. However, there is nothing in the prior art to teach or suggest that the call-screening feature has any impact on the operation of an entertainment module. Therefore, a mobile device simply having both an entertainment module that plays audio and video to a user and a call-screening feature that blocks incoming calls is not the same as the invention of claims 1 and 11, which require that the call-screening feature interrupt the operation of the entertainment module when the caller is listed on a predefined list of callers. As such the prior art does not teach the claimed invention.

Further, claims 1 and 11 explicitly require muting or stopping the playback of the audio and/or video when the user receives an incoming call from a caller on a pre-approved list. The Examiner asserts that this is an obvious result of Chin's teachings. However, Chin actually does the opposite from what is explicitly required by claims 1 and 11. In particular, when a user in Chin receives a call from a caller on the predetermined list, a pre-recorded message will begin to play to the caller, not stop it.

This is vastly different from the requirements of claims 1 and 11. That is, claims 1 and 11 require the device to stop or mute playback of audio and/or video responsive to the incoming call, while Chin requires the device to begin playback of a pre-recorded message responsive to an incoming call on a pre-approved list. The fact that Chin provides a caller ID function for the user means nothing. Beginning the playback of a simple pre-recorded message responsive to an incoming call does not teach or suggest stopping the playback of audio and/or video responsive to the incoming call. Therefore, Chin does not teach or suggest the screening memory limitation of claims 1 and 11.

Because the prior art fails to teach or suggest the screening memory limitation of claims 1 and 11, the prior art does not teach each and every limitation of the claims as required under §103. As such, claims 1 and 11 are novel and non-obvious over the cited art. Further, because independent claims 1 and 11 are patentably distinct, dependent claims 2 – 9 and 12 – 18 are also patentably distinct. Applicants respectfully request reconsideration.

Allowable Claims

On page 8 of the pending Office Action, the Examiner indicated that claims 6 and 7 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. To that end, Applicants submit new independent claims 24 and 25. Claim 24 represents an independent claim that combines the limitations of original claim 1 and dependent claim 6. Similarly, claim 25 represents an independent claim that combines the limitations of original claim 1 and dependent claim 7. As such, claims 24 and 25 are allowable.